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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,462	01/13/2000	Per S. Andersen	0459-0391P	7006

7590 10/22/2002

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/22/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/482,462

Applicant(s)

ANDERSEN ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 22 August 2002 have been fully considered but they are not persuasive. A detailed explanation is given after pertinent parts of the following final rejection.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as obvious over by Witek et al. in view of NEXPO '97.
4. Applicant noted (p. 2) that the prior Office action rejected claims 1-24 "under 35 U.S.C. 102(e) as obvious over by Witek et al. in view of NEXPO '97." The "102(e)" was a typographical error. Since the prior Office action did quote the correct part of the US Code (par. 2 above) and had the correct heading for a 103 rejection, and because the phrase "obvious over" was used in the rejection, examiner believes that the correction herein does not constitute a new basis for rejection.
5. Witek et al. teaches (independent claims 1 and 19) a system and method for advertisement sales and management, the system comprising (Fig. 1) data storage and database means 20, retrieval means 14, processing means 16 and 26, and a number of workstations (computer terminals 22), one or more being adapted to entering advertisement orders (col. 5 lines 28-31), the database and data processing means being adapted to store and manage data relating to an advertising customer (user), order, medium or media, schedule, contents and presentation elements (col. 5 lines 28-31; col. 56 lines 8-10; col. 48 line 14; col. 46 lines 7-9; and col. 42 lines 10-16); defining the advertisement on the basis of entered order data (col. 8 lines 60-61); the system and method thereby supporting entry, sale and management of ads in several media (col. 56 lines 8-10) based on entry of a single advertising order.

Art Unit: 3622

6. Witek et al. does not teach entry, sale and management of several related ads based on entry of a single advertising order. NEXPO '97. teaches reusing content (pp. 27 of 40, first full para.), which reads on entry, sale and management of several related ads based on entry of a single advertising order. Because this convenience would reduce cost and encourage advertising sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al.
7. Applicant argues (p. 3-4) that the rejection in para. 6 does not constitute a proper prima facie case of obviousness in view of three recent CAFC decisions (*In re Dembiczak*, *In re Kotzab* and *In re Lee*). Applicant argues that the rejection fails to provide particular factual findings as to the motivation or suggestion to combine the references.
8. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. This principle was well explicated by *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is the economic incentive to reduce costs and expand sales. A worker could not stay in business, which is to say could not be one of ordinary skill in the art, without understanding the need to continually take advantage of new ways of doing business.
9. NEXPO '97. teaches "easier production of multiple publications" (*op cit.*), which suggests reducing costs for multiple publications. Furthermore, from an understanding of elementary economics, which is also a hallmark of one of ordinary skill in the art, it follows that this efficiency advantage would be expected to lead to increased sales at lower average sale price. (The production unit cost saving would be reflected as a downward shift in the supply curve, thereby intersecting the demand curve at a point of increased sales volume and lower price.) In marketing terms, the publisher salesman would now be able to offer the advertiser an incentive to makes buys in more publications.
10. Applicant argues (p. 4 middle para.) that reuse of content is not the same as entry, sale and management of several related ads based on entry of a single advertising order. But applicant fails to show any distinction.

Art Unit: 3622

11. Witek et al. also teaches claims 2-5, 7, 9 and 20-22 at the locations indicated above. Witek et al. also teaches: (claims 11 and 12) that the customer agrees with the price of the ad, determined dynamically at the time of the order (col. 56 lines 25-31); (claims 14 and 15) the Internet (title); and (claims 16 and 17) a GUI related to a target media (Fig. 8-10, description beginning at col. 23 line 44).
12. Applicant argues (p. 4 bottom) that “examiner has failed [in para. 11 above] to even attempt to identify the specific portions of Witek et al. which teach the subject matter recited in each of these dependent claims [2-5, 7, 9 and 20-22].” Examiner has identified the specific portions in para. 5 above. Examiner has not correlated each claim with each portion, but believes that this identification, with the marked copy of the reference provided to applicant, is sufficient with little labor to refute the prima facie argument if it can be refuted.
13. Witek et al. does not teach (claim 23) editing and re-storing the ad contents and presentation elements. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the NEXPO '97 teaching of content reuse. As evidence tending to show inherency, it is noted that ads are generally not identical from one publication to the next, requiring some sizing or other editing, and would accordingly have to be re-stored in order to be reused.
14. Witek et al. does not teach the presentation element limitations of claim 6, but since the reference does teach formatting the presentation for the user (col. 42 lines 15-16), at least some of these presentation element limitations must be inherent. That is, formatting necessarily requires that the ad have a size, that the printed ad have a typeface or font, etc.
15. Applicant argues (p. 5 beginning with the second para.) that the previous draft of para. 14 was probabilistic, and therefore did not meet the test that inherent properties must be necessary. The last sentence has been added to make the necessity clear. Para. 13 has been rewritten in response to a similar criticism (bottom of p. 5).
16. Witek et al. does not teach (claim 8) that the physical presentation of the ad is established on the basis of data relating to contents. NEXPO '97. teaches observing content-related restrictions (pp. 13 of 40, last full para.), which reads on establishing the physical presentation of the ad on the basis of data relating to contents. Because advertisers would be very displeased if content-related restrictions were not maintained, it would have been

Art Unit: 3622

obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of NEXPO '97 with those of Witek et al.

17. Witek et al. does not teach (claim 10) determining price of the ad based on attributes associated the ad. However, the reference does teach presenting the user with rate information (col. 56 line 26). Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to determine price of an ad based on attributes such as its size or colors. Because it is efficient to accept common or standard practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine the price of the ad based on attributes associated the ad.
18. Traverse of the taking of Official Notice - At p. 6, last para., of the arguments, applicant has traversed the examiner's taking of official notice (in para. 17 above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). Simply put, examiner contends that large ads generally coast more to publish than small ads, or that colored ads generally cost more to publish than black-and-white ads. Applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt as to the fact of this contention. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.
19. Witek et al. does not teach (claim 18) modifying the GUI without modifying binary code. The reference invention uses GUI for the user menus (Fig. 8-10, description beginning at col. 23 line 44). Because these menus differ for each participating newspaper (col. 6 lines 22-23) and can be expected to require frequent changes, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modifying the GUI without modifying binary code.
20. Witek et al. does not teach (claims 13 and 24) a WYSIWYG editor. Because it is ideal for modifying the user menus (para. 19 above), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide a WYSIWYG editor.
21. Applicant argues that the rejection of claims 18, 13 and 24 (para. 19 and 20) lack statements of motivation. The statements are given after "Because" in each case.

**Conclusion**

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
25. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9235.
26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, and as a matter of economic necessity, prosecution generally ends with the final rejection. If applicant believes that the examiner, Dr. Champagne, has made a grievous error justifying withdrawal of the final rejection, the examiner will consider brief arguments, preferably no more than 25 words. Longer argument is not deemed appropriate after final. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into

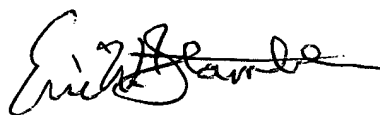
Art Unit: 3622

condition for allowance, clearly and without additional search or more than nominal consideration.

27. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter.

28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DLC  
19 October 2002

  
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